



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,156	12/05/2001	John G. Sotos	021262-000110US	5725

20350 7590 09/08/2006

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

HAFIZ, TARIQ R

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,156

Applicant(s)

SOTOS, JOHN G.

Examiner

Linda Krisciunas

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The following is a Final office action in response to the applicant's amendments filed August 11, 2006. Claims 1-38 are pending, with claims 34-38 being newly added.

Response to Amendment

2. The Examiner has fully considered the claim amendments and they are addressed below in the art rejection.

Response to Arguments

3. All statements of Official Notice made in the art rejection have been on record since issuance of the Non-Final office action rejection mailed on April 11, 2006, and in the subsequent response filed on August 11, 2006 the Applicant was silent on the matter of Official Notice. Consequently, the statements of Official Notice made in the art rejection have been established as admitted prior art due to Applicant's failure to adequately traverse the Examiner's assertions of Official Notice.

The Examiner has fully considered the arguments, but they are deemed not persuasive. With respect to the argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., teach "entities having expertise in one or more subjects in health care fields" as cited on the second page of the Remarks section) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Information Disclosure Statement

4. The information disclosure statement filed May 24, 2002 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because there is no copy of PTO/SB/08A. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a). This was also cited in the previous office action filed April 11, 2006.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5 and 10-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milic-Frayling et al (US 2006/0059138) in view of The National Library of Medicine internet home page (www.webarchive.com from the year 2000), hereinafter referred to as "NLM".

As per claims 1 and 30, Milic-Frayling teaches querying a database for documents relevant to a subject (paragraph 32, where the system can be operated on a variety of computer based systems, including data structures which would include databases); calculating a first score for each relevant document (paragraph 13, where the items are ranked which would require some sort of scoring system); determining entities affiliated with one or more relevant documents, each of the entities being affiliated with one or more documents in a set, at least one of the entities includes an institution or person affiliated with the set of the one or more documents (paragraph 14, where relevance is determined which is equivalent to affiliation as it performs an identical function in substantially the same manner with substantially the same results. See also paragraph 102 where summaries can be generated based on related articles, where a link is provided that allows the user to verify the relevance of the article. See also paragraph 8 where document text is used to identify and extract entities of particular interest, for example, a person's name, company names, locations, document relevance etc. The use of a person's name or company constitutes an affiliation or person affiliated.); calculating a second score for each entity based on the one or more first scores of the relevant documents affiliated with the entity; ranking expertise of the entities based on the respective second scores of the entities (paragraph 13, where the document can be re-ranked according to a specific criteria from a prior search, where re-ranking would constitute some sort of scoring system); and displaying expertise associated with the respective entities to a user (paragraphs 14-16 where the user can chose a subject for search and a relevance assessment of the documents is provided.

Additional information regarding the extraction of certain types of entity names or entity relations that are contained in the document can also be provided. The relevance assessment constitutes an expertise associated with the document.).

Milic-Frayling does not explicitly teach subjects in the health care field, but this is merely intended use. The prior art reference(s) fail to have the same intended use and/or purpose, the examiner asserts that the recitation of the intended use or purpose of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use or fulfilling said purpose, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987). NLM teaches that it is known to search documents in the health care field (pages 1-8). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the document search system of Milic-Frayling with documents from the health care fields, such as in NLM, to provide means for finding articles related to this subject area.

As per claims 2-4 and 11-12, Milic-Frayling teaches ranking of expertise of the entities to a user, graphically depicting levels of expertise and numerically depicting expertise (paragraph 85, where the information is scored and listed accordingly. Official notice is taken that it is old and well known to use numbers or graphs to display the rank of items. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ranking system of Milic-Frayling with a numerical or graphical ranking system in order to provide a more user-friendly system.).

As per claims 5, 10 and 34, Milic-Frayling teaches calculating a third score for each of the plurality of geographic areas based on the respective second scores of entities located within the each of the plurality of geographic area; and displaying expertise associated with each of the plurality of geographic areas to the user, based on the respective third scores of the plurality of geographic areas (paragraph 13, where the document can be re-ranked according to a specific criteria from a prior search, where re-ranking would constitute some sort of scoring system. The process is not limited in number of times it can re-rank the data, therefore third scores would be encompassed by the re-ranking feature of Milic-Frayling. See also paragraphs 14-16 where the user can chose a subject for search and a relevance assessment of the documents is provided. Additional information regarding the extraction of certain types of entity names or entity relations that are contained in the document can also be provided. The relevance assessment constitutes an expertise associated with the document).

As per claims 13-18, Milic-Frayling teaches the first score is based on a type of the document (paragraph 85, where scoring (525) is one of several well known relevance matching functions with respect to the model of the user's interest.).

As per claims 19-20, Milic-Frayling does not explicitly teach authors affiliated with the documents. NLM teaches that it is known the entities affiliated with one or more documents include authors of the one or more documents (pages 3-5). NLM is an analogous art as it also teaches about document retrieval. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the

document system of Milic-Frayling with the author feature of NLM to provide a more comprehensive and user-friendly system.

As per claims 21-29, Milic-Frayling does not explicitly teach medical databases. NLM teaches that it is known that the database of documents is at least one of the Medlars databases (See page 2, where NLM provides free access to PubMed and Internet Grateful Med which connect to multiple medical databases.). NLM is an analogous art as it also teaches about document retrieval. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the document system of Milic-Frayling with the medical database feature of NLM to provide a more comprehensive and user-friendly system.

As per claims 31-33, Milic-Frayling teaches the server is coupled to the database via the world wide network of computers (paragraph 65, where the user can search using the Web via a browser and paragraph 35: "Personal computer 20 may operate in a networked environment using logical connections to one or more remote computers such as remote computer 49. Remote computer 49 may be another personal computer, a server, a router, a network PC, a peer device, or other common network node. It typically includes many or all of the components described above in connection with personal computer 20; however, only a storage device 50 is illustrated in FIG. 1. The logical connections depicted in FIG. 1 include local-area network (LAN) 51 and a wide-area network (WAN) 52. Such networking environments are commonplace in offices, enterprise-wide computer networks, intranets and the Internet.").

As per claim 35, Milic-Frayling teaches the score is based on the number of authors associated with each of the documents (paragraph 47 where the linguistic and knowledge resources are used for identifying company names or author names. See also Figure 7 where the system can identify entity names and relations in the document (725), whereby this would be used in conjunction with paragraph 8 where a relevance assessment is made which constitutes a scoring based upon the names associated with the document.).

As per claim 36, Milic-Frayling teaches the score is based on the type of document of each document relevant to each entity (paragraph 47 where the format recognition and content analysis would constitute means for assessing the document type. See also paragraph 60 where the format, or type, of document can be filtered as well.).

As per claim 37, Milic-Frayling teaches the query is a geographical area (paragraphs 8 and 13 indicate location, or geography, as one of the search criteria that is scored as part of the ranked results.).

As per claim 38, Milic-Frayling teaches the entity is selected from a hospital, university or author (paragraph 47 where the linguistic and knowledge resources are used for identifying company names or author names. See also Figure 7 where the system can identify entity names and relations in the document (725), whereby this would be used in conjunction with paragraph 8 where a relevance assessment is made which constitutes a scoring based upon the names associated with the document.).

7. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milic-Frayling in view of The National Library of Medicine internet home page (www.webarchive.com from the year 2000), hereinafter referred to as "NLM", in further view of "Creating a CD-ROM: Overview of the product field. (CD-ROM authoring and data retrieval software packages; includes company directory and related article on resources for doing research)", Buyers Guide by Bernard Banet, Seybold Report on Desktop Publishing, v7, n6, February 1, 1993; hereinafter referred to as "Banet".

As per claim 6, Milic-Frayling nor NLM explicitly teach determining the author and institution of the document. Banet teaches that it is known to determine an author of the document (page 3, paragraph 4: "fields such as author, date, title, subject and so on"); and determining from what one or more institutions the document emanated (page 18, paragraph 10, where a bibliography is indicated which would contain institution or company information). Banet is an analogous art as it also teaches about document retrieval. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the document system of Milic-Frayling in view of NLM with the author/institution feature of Banet to provide a more comprehensive and user-friendly system.

As per claims 7-9, Milic-Frayling nor NLM explicitly teach determining the address. Banet teaches that it is known to examine an address of the determined author, where the address is a mailing address, where the address is an e-mail address (page 3, paragraph 6, where address or contact information is indicated). Bernard is an analogous art as it also teaches about document retrieval. Therefore it would have been

obvious to one of ordinary skill in the art at the time of the invention to modify the document system of Milic-Frayling in view of NLM with the address feature of Bernard to provide a more comprehensive and user-friendly system.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

9. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Krisciunas whose telephone number is 571-272-6931. The examiner can normally be reached on Monday through Friday, 6:30 am to 3:00 pm.

Art Unit: 3623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LMK

LMK
August 31, 2006

Romain Jeanty
Primary Examiner
Art Unit 3623